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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,332	09/17/2003	Peter Hamilton	10121/01705	5439

7590 10/01/2007  
FAY KAPLUN & MARCIN, LLP  
Suite 702  
150 Broadway  
New York, NY 10038

EXAMINER
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PRIDDY, MICHAEL B

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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10/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/665,332	HAMILTON, PETER
	Examiner	Art Unit
	Michael B. Priddy	3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 03 July 2007.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 29-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 29-31, 33 and 34 is/are rejected.
- 7) Claim(s) 32 and 35 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Terminal Disclaimer*

The terminal disclaimer filed on 07/03/2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,648,897 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-31, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneebaum et al. (US 5,423,830) in view of Nakao et al. (US 5,190,542). Schneebaum et al. teach a method for removing an object from a patient comprising: inserting into the body cavity an endoscope (lines 3-8 of claim 1 of '830); advancing a flexible cup through a lumen of the endoscope in a folded insertion configuration and advancing the flexible cup distally from the lumen of the insertion device, wherein the flexible cup deploys to an operative configuration in which the flexible cup is substantially funnel shaped as it exits the lumen (lines 3-5 and 9-16 of claim 1 of '830); applying a vacuum pressure to an interior of the flexible cup to draw the

selected portion of tissue thereinto (lines 20-24 of claim 1 of '830); positioning the endoscope to view the selected portion of tissue (lines 23-24 of column 5) and maneuvering the flexible cup relative to the endoscope (lines 17-18 of claim 1 of '830); severing the selected portion of tissue from surrounding tissue (lines 20-23 of claim 2 of '830); withdrawing the flexible cup proximally relative to the insertion device to alter a position of the selected portion of tissue relative to the insertion device while maintaining vacuum pressure within the flexible cup to retain the severed tissue within the flexible cup (lines 25-26 of claim 1 and lines 32-33 of claim 11 of '830).

Concerning the language "visually positioning the flexible cup adjacent to the selected portion of tissue," Schneebaum et al. clearly teach this action with the disclosure "to bring the opened web member 22 into juxtaposition with polyp PO," and "visually" only requires the surgeon have his eyes open which is being considered inherent. Furthermore, by observing the selected portion of tissue at least partially through the flexible cup," the Examiner has interpreted "observing" to not require visually witnessing. At lines 35-40 and 43-44 of column 5, Schneebaum has disclosed "effectively locking the polyp in the web member" and "clamping of polyp PO by ribs 26 and web member 22." It is considered inherent that the operator of the retrieval device 10 would observe the polyp tactiley through the contact of web member 22 with said polyp.

Concerning the language "fastening portions of tissue around a periphery of the selected portion of tissue," it is noted that what the portions of tissue are to be fastened to has not been claimed and because of this the claim merely requires these portions of

tissue be fastened to something. The polyp of Schneebaum et al. is integral with portions of tissue around a periphery of the polyp and therefore fastened thereto. Upon drawing the polyp into the flexible cup, the polyp is fastened thereto and the "portions of tissue" are indirectly fastened to the flexible cup through the polyp.

Hence Schneebaum et al. teach all of the limitations of the present invention except the flexible cup being transparent. It would have been obvious to one having ordinary skill in the art at the time the invention was made to describe form the flexible cup disclosed by Schneebaum et al. of biologically inert flexible transparent synthetic resin or polymeric material such as polyethylene or nylon, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. It should be noted that Nakao et al. have disclosed a web made of "biologically inert flexible transparent synthetic resin or polymeric material such as polyethylene or nylon."

#### ***Allowable Subject Matter***

Claims 32 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 07/03/2007 have been fully considered but they are not persuasive. Applicant has argued Schneebaum does not teach "applying a vacuum pressure to an interior of the flexible cup *to draw the selected portion thereinto.*"

The Examiner notes that draw is synonymous with "pull" and that because the method disclosed by Schneebaum pulls on the polyp PO once the polyp PO is enclosed within cup 22 (as would be required to aid in maintaining polyp PO within cup 22), polyp PO is being pulled on by the vacuum source. Therefore, the vacuum pressure of Schneebaum *draws the selected portion thereinto.*

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is 571-272-2243. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael B. Priddy  
  
September 26, 2007

  
EDUARDO C. ROBERT  
SUPERVISOR, PATENT EXAMINER